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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,275	08/01/2003	Chris Graham	MSFT-2187/304791.2	5468

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EXAMINER

OSMAN, RAMY M

ART UNIT

PAPER NUMBER

2157

MAIL DATE

DELIVERY MODE

05/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,275

Applicant(s)

GRAHAM ET AL.

Examiner

RAMY M. OSMAN

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is responsive to application filed on August 1, 2003. Claims 1-32 are pending examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-8 recite an “email comprising...”, and claims 9-16 recite a “document comprising”. If indeed Applicant is attempting to claim an “email”, then this is nothing but a data structure which does not fall within any of the statutory categories. And if Applicant is attempting to claim a “document” then this is nonfunctional descriptive material which also does not fall within any of the statutory categories. The claims are not directed to a process since its not a series of steps. The claims are also not directed to a machine since its not a device(s), nor directed to a manufacture since its not produced from raw materials. And they are also clearly not directed to a composition of matter and are therefore nonstatutory. **See MPEP Chapter 2106.01 Section I.**

4. Claims 17-32 states, “A computer readable medium ...”. Paragraph 42 of Applicants disclosure (see PG Publication 2004/0267889) mentions that “computer readable medium” encompasses “communication media” which includes instructions, data structures and modules which are regarded as programs per se, and also includes “modulated data signal such as a carrier

wave or other transport mechanism". "Programs per se" are non-statutory, and signals are also non-statutory. It is clear that the scope of the claimed computer readable medium is intended to cover communication media which includes programs per se, and also includes signals, neither of which are statutory. These claims do not fall within any of the statutory categories and are therefore not patentable subject matter. **See MPEP Chapter 2106 Section IV.B.¶4 and Chapter 2106.01**

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-32 rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al (US Patent No 5,325,310).

7. In reference to claim 1, Johnson teaches an email comprising a body having at least one related and previously sent email, each previously sent email being represented in the body of the email as a body object, each of the email and each body object therein being rights-managed as protected content (column 6 lines 42-56 and column 8 lines 21-45, discloses reply attributes of messages), whereby a recipient of the email can render the protected content of each of the email and each body object therein with a corresponding license if the recipient satisfies terms set forth in the license.

8. In reference to claim 2, Johnson teaches the email of claim 1 wherein each previously sent email was itself rights-managed as protected content according to predefined rights data, and wherein the corresponding body object in the body of the email is also rights-managed as protected content according to the same predefined rights data (column 4 lines 33-53, discloses persistent reply attributes).
9. In reference to claim 3, Johnson teaches the email of claim 1 wherein the body has a plurality of related and previously sent emails, the plurality of previously sent emails being represented in the body of the email as a plurality of serially arranged body objects (column 8 lines 21-45).
10. In reference to claim 4, Johnson teaches the email of claim 1 wherein the body has a plurality of related and previously sent emails, the plurality of previously sent emails being represented in the body of the email as a plurality of nested body objects (column 8 lines 21-45).
11. In reference to claim 5, Johnson teaches the email of claim 1 wherein the at least one related and previously sent email is split into multiple parts, each part being represented in the body of the email as a body object, each of the email and each body object therein being rights-managed as protected content (column 6 lines 42-56, inherent that one email is distinguishable from the other).
12. In reference to claim 6, Johnson teaches the email of claim 5 wherein the at least one related and previously sent email was itself rights-managed as protected content according to predefined rights data, and wherein the corresponding body object of each part in the body of the email is also rights-managed as protected content according to the same predefined rights data (column 6 lines 42-56).

13. In reference to claim 7, Johnson teaches the email of claim 5 wherein a portion of the body is interposed between a pair of the multiple parts of the previously sent email, the portion comprising a comment on such previously sent email (column 8 lines 21-45).

14. In reference to claim 8, Johnson teaches the email of claim 7 wherein the portion is a body object (column 8 lines 21-45).

15. In reference to claims 9-16, these are document claims that correspond to the email claims of claims 1-8. Therefore, claims 9-16 are rejected based upon the same rationale as given for claims 1-8 above.

16. In reference to claims 17-24, these are computer readable medium claims that correspond to the email claims of claims 1-8. Therefore, claims 17-24 are rejected based upon the same rationale as given for claims 1-8 above.

17. In reference to claims 25-32, these are computer readable medium claims that correspond to the email claims of claims 1-8. Therefore, claims 25-32 are rejected based upon the same rationale as given for claims 1-8 above.

Conclusion

18. The above rejections are based upon the broadest reasonable interpretation of the claims. Applicant is advised that the specified citations of the relied upon prior art, in the above rejections, are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and/or priority documents) is implied as being applied to teach the scope of the claims.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ramy M Osman/
Primary Examiner, Art Unit 2157
May 14, 2008